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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/344,411 06/26/99 CORPUS

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WATTS HOFFMANN FISHER & HEINKE CO LPA
P O BOX 99839
CLEVELAND OH 44199-0839

EXAMINER

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/344,411

Applicant(s)

CORPUS ET AL.

Examiner

Alicia Chevalier

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 38, and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The objections to the drawings and the 35 U.S.C. §112 rejections of record in paper #7, pages 4-5, paragraph #2-4 have been withdrawn due to Applicant's amendment in paper #10.
2. The 35 U.S.C. §103 rejections of record in paper #7, pages 5-12, paragraphs #6-11 have been withdrawn due to Applicant's amendment in paper #10.

REJECTIONS REPEATED

3. The 35 U.S.C. §102 rejection of claims 1, 2, 6-12, 14, and 17 as anticipated by Cleef (2,248,317) is repeated for reasons previously of record in paper #7, pages 5-6, paragraph #6.
4. The 35 U.S.C. §102 rejection of claims 1, 2, 6, 7, 10, 13, and 17 as anticipated by Bowskill (4,795,669) is repeated for reasons previously of record in paper #7, page 6, paragraph #7.

NEW REJECTIONS

5. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Cleef (2,248,317) for reasons previously of record in paper #7, pages 5-6, paragraph #6.

As for the new limitation that the active agent is chosen from the group consisting of anti-bacterial agents, disinfectants, insect repellants, fragrances, fluid resistant agents and anti-mildew agents. Cleef discloses that the vulcanized rubber layer is provided with a thin coating of shellac, varnish, lacquer, ethyl cellulose (col. 2, lines 19-32), which are all well known fluid resistant agents.

8. Claims 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Cleef (2,248,317).

Cleef discloses a sticker packet comprising a plurality or set of superposed stickers. The stickers are adapted when stripped apart or separated from one another to be stuck to any selected surface of object and, depending upon their shape, serve as articles of utility or ornamentation.

The stickers are thin and flexible and are secured together in packet form by means of facings of permanently tacky pressure-sensitive adhesive (col. 2, lines 2-10). The stickers are made of base material of paper or like material. The base is impregnated with rubber latex and embodies on the outer face thereof a vulcanized rubber layer. The vulcanized rubber layer is provided with a thin coating of shellac, varnish, lacquer, or ethyl cellulose in order to prevent the permanently tacky pressure-sensitive adhesive from sticking too tightly (col. 2, lines 19-32). A holland strip is added to the lower most sticker (last leaf without adhesive) (col. 2, lines 46-51).

As shown in figure 1, the stickers are provided with integral outwardly projecting tabs (col. 3, lines 4-6).

9. Claims 1, 2, 3, 7, 10, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bloomer (5,597,634).

Bloomer discloses changeable media labels with a base layer which can be adhesively attached to a recording media contained (abstract). The label pad includes a base label layer with a first adhesive of first adhesive strength and a plurality of label segments on top of the base layer with a second peelable adhesive of second adhesive strength which is weaker than the first adhesive strength (col. 3, lines 12-32).

10. Claims 1, 2, 5-9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Forman (5,712,012).

Forman discloses an adaptable disposable placemats comprising hydrophobic or water-resistant coating, a cellulosic layer, and an adhesive layer (col. 3, lines 9-15). A plurality of disposable placements can be stacked together and adhered to one another by their adhesives strips to provide a convenient package for shipping and storage (col. 3, lines 24-35, figure 3). The last placemat in the stack is provided with a supplemental release strip or similar backing layer.

Claim Rejections - 35 USC § 103

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowskill (4,795,669).

Bowskill generally discloses the claimed limitations of the instant application of record in paper #7, page 6, paragraph #7 except for the adhesive on the tab being on both sides. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have adhesive on both sides of the tab, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments filed in paper #10 regarding the objections to the drawing and the 35 U.S.C. §112 rejections of record have been considered but are moot since the rejections have been withdrawn.

13. Applicant's arguments filed in paper #10 regarding the 35 U.S.C. §102 rejection as anticipated by Cleef '317 have been carefully considered but are deemed unpersuasive.

In response to Applicant's argument that Cleef '317 does not teach the mounting of the entire packet to a surface to be covered, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d (1987). Also, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. Therefore, the limitation "said last leaf is adapted to mount said stack to a surface to be covered" is give little patentable weight.

Applicant's argues that Cleef '317 does not disclose or suggest a last leaf with a second surface comprising adhesive of sufficient strength to prevent the stack from lifting during

removal of individual. This new limitation “of sufficient strength to prevent lifting of said stack during removal of individual leaves” is considered to be an intended use phrase. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant argues that Cleef ‘317 discloses during use of individual stickers the “bottom or lower-most sticker of the packet is protected from adhering to other objects by way of a holland sheet.” First, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. Secondly, the fact that Cleef ‘317 includes additional structure not required by Applicant’s invention, it must be noted that Cleef ‘317 discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant. Finally, as applicant points out the instant claimed surface covering also comprises a protective sheet in claim 9. So, the fact that the applicant removes his protective sheet before use is irrelevant since it is an intended use.

In response to Applicant’s argument that the stack of stickers in Cleef ‘are not directed toward application on a surface as a stack, only as individual stickers, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

14. Applicant’s arguments filed in paper #10 regarding the 35 U.S.C. §102 rejection as anticipated by Bowskill ‘669 have been carefully considered but are deemed unpersuasive.

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In response to Applicant's argument that Bowskill '699 does not teach mounting the stack to the surface to be protected, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

Applicant's argues that Bowskill '699 does not teach the feature of adhesive having sufficient strength to prevent the stack from lifting during removal of individual leaves. This new limitation "of sufficient strength to prevent lifting of said stack during removal of individual leaves" is considered to be an intended use phrase. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

In response to Applicant's argument that Bowskill '699 does not the application of the stack as a whole to the surface to be protected, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

15. Applicant's arguments filed in paper #10 regarding the 35 U.S.C. §103 rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sullens (6,177,164) discloses a similar surface covering.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

04/19/01


BLAINE COPENHEAVER
PRIMARY EXAMINER